

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

TESSERA ADVANCED TECHNOLOGIES,
INC.

Plaintiff,

v.

SAMSUNG ELECTRONICS CO. LTD. AND
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Case No. 2:17-cv-00671-JRG

JURY TRIAL REQUESTED

**TESSERA ADVANCED TECHNOLOGIES, INC.'S SUR-SURREPLY
CLAIM CONSTRUCTION BRIEF**

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Exhibit Number	Description
1-20	These numbers refer to the attachments to Tessera's Opening Claim Construction Brief
21-25	These numbers refer to the attachments to Tessera's Reply Claim Construction Brief

I. TESSERA’S CONSTRUCTIONS SHOULD BE ADOPTED

A. “fill up”

In its Surreply, Samsung does not dispute that it intends to limit the phrase “fill up” to just one of its plain and ordinary meanings. (*Cf.* TATI Reply Br. at 7-8.) Nor does it point to any disclaimer or dispute that its implicit construction reads out preferred embodiments of the patent expressly described in the specification. (*Cf. id.*) Instead Samsung erroneously relies on not-to-scale patent figures that it claims support its construction. This is insufficient as a matter of law. *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d 1323, 1333 (Fed. Cir. 2007) (“[P]atent coverage is not necessarily limited to inventions that look like the ones in the figures . . .”).

Samsung argues that the Court should rely on not-to-scale patent figures to find that its construction does not read out a preferred embodiment because Tessera relied on a modified figure that is based on explicit dimensions in the specification. (Samsung Surreply at 1; Ex. 21 (providing unrebutted testimony that the figures are not to scale).) This argument is a non-sequitur. Samsung’s reliance on not-to-scale figures is legal error and Tessera’s recreation of a figure based on dimensions set forth in the specification is entirely proper.¹ See *Hockerson Halberstadt, Inc. v. Avia Grp. Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000) (“[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” (internal citations omitted)).

Samsung attempts to distance itself from *Hockerson Halberstadt* by identifying two cases where patent figures were purportedly relevant to claim construction. (Samsung Surreply at 1.)

¹ Samsung accuses Tessera of an “abrupt change in position.” (Samsung Sur Reply at 1.) Not so. Tessera provided to-scale figures to illustrate the dimensions expressly taught by the specification. There is nothing inconsistent with Tessera relying on *to-scale* figures and rejecting Samsung’s *not-to-scale* figures.

But neither of these cases relied on not-to-scale patent figures to override express dimensions in the specification, as Samsung attempts to do here. In fact, neither case was even concerned with the dimensions of the figures. Instead, *Theta IP LLC v. Samsung Elecs. Co.*, merely held that two figures accompanied by a **consistent** disclosure in the specification illustrated that one signal was relatively stronger than another. No. 2:16-CV-527-JRG-RSP, 2017 WL 2444715, at *14 (E.D. Tex. June 6, 2017) (citations omitted). Even farther afield is *CVI/Beta Ventures, Inc. v. Tura LP*, where the Federal Circuit relied on figures containing **graphs** of stress and strain to provide guidance as to the meaning of “elasticity.” 112 F.3d 1146, 1153 (Fed. Cir. 1997). Neither of these cases suggests that it is appropriate to limit the claims or rewrite embodiments by measuring a not-to-scale patent figure. (Cf. Samsung Resp. Br. at 24.) It is not. *Hockerson Halberstadt*, 222 F.3d at 956 (citing *See In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977) (“Absent any written description in the specification of quantitative values, **arguments based on measurement of a drawing are of little value.**”)).

Samsung also argues that *Hockerson Halberstadt* is irrelevant where the dimensions of a figure are not at issue. (*Id.* at n.1.) But the dimensions of the depicted embodiment are at issue here—the embodiment of the figures described in the specification has express dimensions which do not “fill completely” the openings, as Samsung contends the claims require. (Compare Samsung Resp. Br. at 25 with Ex. 21 ¶ 9.) The Court should reject Samsung’s attempt to argue an implicit claim construction to the jury that reads out all preferred embodiments.

B. “first, thin conductive film” and “second, thick conductive film”

Samsung’s Surreply does not address Tessera’s position. In particular, Tessera explained that the terms “thin” and “thick” are used to indicate that the “first, thin conductive film” is thinner than the “second thick conductive film.” (TATI Reply Br. at 4; Ex. 21 ¶ 2.) Samsung does not dispute that this is the plain and ordinary meaning of the term to a person of skill in the art. (*See*

Samsung Surreply at 2-4.) Nor does Samsung suggest that a person of skill in the art would have any difficulty identifying which of two films is thicker. (*Id.*)

Instead, Samsung cites to a handful of cases finding certain terms of degree indefinite, but it is well-settled that terms of degree are regularly held to be definite. *See, e.g., One-E-Way, Inc. v. Int’l. Trade Comm’n*, 859 F.3d 1059, 1063 (Fed. Cir. 2017) (“As long as claim terms satisfy [the *Nautilus*] test, relative terms and words of degree do not render patent claims invalid.”). And the standard for definiteness (regardless of whether a term is one of degree) is whether “the patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with **reasonable certainty**.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014). And Samsung makes no effort to argue that the plain meaning proposed by Tessera cannot be ascertained with “reasonable certainty.” Nor could it. It is beyond dispute that a person of skill in the art can readily identify if a first conductive film (e.g., a seed film) is thinner than a second conductive film (e.g., an electroplated wire). (Ex. 21 ¶¶ 2; Ex. 1 ¶¶ 50-52.)

Samsung also attempts to argue that its position before the Patent Trial and Appeals Board (“PTAB”) is not inconsistent with its position here because it could have argued (but did not²) that its proposed combination of references used dimensions similar to an exemplary embodiment of the ’616 patent. (Samsung Surreply at n.2.) Samsung appears to contend that it can prevail before the PTAB on its prior art arguments even if the claim is indefinite. This is not current PTAB law. Under PTAB precedent, if a term is indefinite, a petitioner cannot prevail. *See, e.g., Fortinet, Inc. v. Sophos Inc.*, Case IPR2015-00617, Institution Decision (PTAB Aug. 13, 2015) (Paper 9)

² In its IPR petition, Samsung did not argue that the term was indefinite or base its obviousness positions for the elements at issue on any comparison to the embodiments of the ’616 patent. (*E.g.* Ex. 7 at 45-49.) It simply applied the plain meaning of claims. (*Id.*)

(“Independent claim 9, however, recites [a] limitation, . . . which we determined is not amenable to construction, as discussed above. *Accordingly, we do not attempt to apply claim 9 to the asserted prior art.*” (citing *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (in the ex parte appeal context, holding that where a claim’s meaning is indefinite under 35 U.S.C. § 112, ¶ 2, a rejection based on prior art is improperly based on speculation); *BlackBerry Corp. v. Mobile Media Ideas, LLC*, Case IPR2013-00036, slip op. 20 (PTAB Mar. 7, 2014) (Paper 65))). Samsung’s position before the PTAB was not taken in the alternative, or by comparing the prior art to an embodiment. (*E.g.* Ex. 7 at 45-49.) Instead Samsung and its expert applied the plain and ordinary meaning (just as Tessera proposes). (*Id.*) In any event, inconsistent or not, the fact that Samsung and its expert had no difficulty repeatedly applying these terms is powerful evidence that the terms are sufficiently definite. *Sonix Tech. v. Publications, Int’l.*, 844 F.3d 1370, 1380 (Fed. Cir. 2017) (“The parties’ experts also had no difficulty in applying ‘visually negligible.’ Dr. Ashok and Dr. Engels repeatedly applied the term to the references and the accused products. . . . [C]ontinued application by the experts in this case further supports the conclusion that a skilled artisan did understand the term with reasonable certainty.”).

The Court should reject Samsung’s indefiniteness argument.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this notice was served on all counsel of record who have consented to electronic service as this district requires in accordance with Local Rule CV-5(a)(3)(A) on this 5th day of September, 2018.

/s/ Andrea Fair